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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/021,890

10/31/2001

Shinya Kogure

CANO:038

1962

7590

06/05/2006

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EXAMINER

BLAIR, DOUGLAS B

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/021,890	Applicant(s) KOGURE ET AL.	
	Examiner Douglas B. Blair	Art Unit 2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Claims 1-9 are currently pending in this application. Claims 1, 6, and 7 have been amended and claims 8-9 are new.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/10/2006 has been entered.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 7 and 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 7 and 9 are claiming a computer-readable storage medium that according to the applicant's specification could be considered "a download through a network" (paragraph 189 of the U.S. PGPUB 2002/0099778, the publication of this application). "A download through a network" is not tangibly embodied and therefore non-statutory.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 9 recites the limitation "a computer readable storage medium according to claim 6" in the preamble of claim 9. There is insufficient antecedent basis for this limitation in the claim. For examination purposes it will be assumed that claim 9 was intended to depend upon claim 7 and not claim 6.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-2 and 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,480,884 to Saito in view of U.S. Patent Number 6,226,630 to Billmers.

10. As to claim 1, Saito teaches a data communication apparatus comprising: an inputter arranged to input file data, which is an electronic mail attachment (col. 5, lines 38-58); a setter arranged to set a subject of an electronic mail to be transmitted based on a user input (col. 7, lines 1-12); a producer arranged to produce a file name of the electronic mail attachment based

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on the subject set by the setter (col. 5, lines 38-58); and a transmitter arranged to transmit electronic mail with the electronic mail attachment, the subject set by said setter, and file name produced by said producer (col. 5, lines 59-67); however, Saito does not explicitly teach the file name being based on the field "SUBJECT:".

Billmers teaches a data communication apparatus comprising: an inputter arranged to input file data (col. 6, lines 48-63); a setter arranged to set a field SUBJECT: of a header of an electronic mail to be transmitted (col. 6, lines 48-63); a producer arranged to produce a file name of the file data input by said inputter based on the field SUBJECT: set by said setter (col. 6, lines 48-63).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Saito regarding emailing images with the teachings of Billmers regarding the naming of a file based on the SUBJECT: field of an email because using the SUBJECT: field of an email provides a meaningful name for the file (Billmers, col. 6, lines 48-63).

11. As to claim 2, Saito teaches a data communication apparatus according to claim 1, wherein said inputter inputs the file data obtained by reading an image on an original (col. 5, lines 38-58).

12. As to claim 4, Saito teaches a data communication apparatus according to claim 1, wherein said producer produces the file name based on a number of the file data input by said inputter and the subject set by said setter (col. 5, lines 38-58).

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13. As to claim 5, Saito teaches a data communication apparatus according to claim 1, wherein said producer produces the file name in accordance with a kind of the file data input by said inputter (col. 5, lines 38-58).

14. As to claims 6-7, they feature the same limitations as claim 1 and are rejected for the same reason as claim1.

15. As to claim 8-9, Saito teaches transmitting the electronic mail with the electronic mail attachment the field SUBJECT: being set by said setter and the file name produced by said producer (col. 5, lines 38-58).

16. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,480,884 to Saito in view of U.S. Patent Number 6,226,630 to Billmers et al. in further view of U.S. Patent Number 6,683,700 to Shiota et al..

17. As to claim 3, the Saito-Billmers combination makes obvious the apparatus of claim1, however the Saito-Billmers combination does not explicitly teach a detachable memory.

Shiota teaches a data communication apparatus wherein the inputter inputs the file data obtained from a detachable memory (col. 3, lines 54-67).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of the Saito-Billmers combination regarding emailing images with the teachings of Shiota regarding detachable memories because detachable memories are common to digital cameras that produce images (Shiota, col. 1, lines 29-37).

***Response to Arguments***

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18. Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

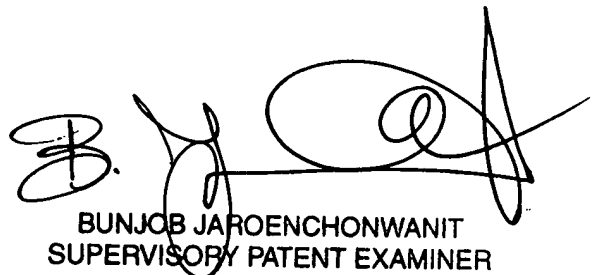
***Conclusion***

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B. Blair whose telephone number is 571-272-3893. The examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Douglas Blair



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SUPERVISORY PATENT EXAMINER